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In re Application of
Sonia E. Sanhueza, et al.
Application No. 08/286,189
Attorney Docket No.: MISMS1038348
Filed: August 5, 1994

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OFFICE OF PETITIONS
A/C PATENTS
ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed March 7, 2001, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed June 21, 2000, which set a shortened statutory period for reply of three (3) months. No extension of time for reply pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the above-identified application became abandoned on September 22, 2000. The instant petition was filed before a Notice of Abandonment could be sent.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (3) and (4) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."³

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."⁴

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁵

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgement for that of the agency."⁶

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷ The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawarness of a PTO rule will not constitute unavoidable delay.⁹

³Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

⁴Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

⁶Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷Id.

⁸See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that the Notice of Appeal which was to be responsive to the final Office action was deposited with DHL Courier ("DHL") on December 20, 2000. Petitioner maintains that it was petitioner's belief and intention that the package containing the Notice of Appeal be sent to the Office via the overnight mail, however; it was not delivered to the Office until a day later (apparently December 22, 2000.) Petitioner asserts that the delay in responding to the final Office action was, therefore, unavoidable because petitioner relied on DHL to deliver the package to the Office the next business day. Petitioner suggests that petitioner made an inquiry to DHL courier as to why the package was delayed, but petitioner had not received a response to the inquiry as of the date the instant petition was authored. Petitioner provided no corroborative documentary evidence to support the aforementioned rendition of facts.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

Although petitioner alleges that: 1) the package containing the Notice of Appeal was deposited with DHL on December 20, 2000, and that 2) petitioner instructed DHL to send the package to the Office via overnight express mail, petitioner has not provided any documentary evidence to support either allegation. The failure of a reputable agency, such as DHL, to render its professed service as promised would ordinarily constitute unavoidable delay. However, in order for petitioner to claim such unavoidable delay, petitioner must establish to the satisfaction of the Commissioner that petitioner did everything that was reasonable and prudent to ensure that the package arrived to the Office on time. Specific attention is called to the *Manual of Patent Examining Procedure*, Section 711.03(c)(2), citing *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912) (quoting *Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 522, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); *Ex Parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913), which seeks to further clarify the "unavoidable" standard and reads, in pertinent part, as follows:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worth and reliable employees and such other instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Petitioner has not satisfactorily shown that ". . . all other conditions of promptness . ." were present relative to the mailing of the Notice of Appeal as no documentary evidence was provided to corroborate petitioner's claim that the Notice of Appeal was actually deposited with DHL on December 20, 2000, or that petitioner properly instructed DHL to mail the Notice of Appeal to the Office in the overnight mail. The aforementioned are assumptions that the Office cannot

make because proof of the same directly impacts whether petitioner's claim of unavoidable delay has been sufficiently established.

Based on the aforementioned, it is the opinion of the Office that item (3) above has not been met.

With regard to item (4) above, a terminal disclaimer as required by 37 CFR 1.137(c) was not filed with the instant petition. A terminal disclaimer, and the requisite fee as provided in 37 CFR 1.321, is required for any utility or plant application filed before June 8, 1995. As the above-cited application was before June 8, 1995, a terminal disclaimer must be filed before any petition filed pursuant to 37 CFR 1.137 can be granted. The "Terminal Disclaimer to Accompany Petition" is attached for petitioner's convenience.

Petitioner is advised that 35 U.S.C. 133 and 151 require that petitioner show not only that the delay resulting in abandonment was unavoidable, but must also show that such unavoidable delay continued until the filing of the instant petition. Section 711.03(c)(2) provides, in pertinent part, that:

[t]he burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon being notified, or otherwise becoming aware, of the abandonment of the application). An applicant who fails to file a petition under 37 CFR 1.137(a) "promptly" upon becoming notified, or otherwise aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

It is not clear from the instant petition, or the application file, when petitioner discovered that application had become abandoned. In order for a petition to be granted pursuant to 37 CFR 1.137(a), however, petitioner must show that the entire delay between the discovery of abandonment of the application until the filing of a grantable petition was unavoidable. Petitioner is cautioned that if a renewed petition is filed under 37 CFR 1.137(a) petitioner must establish that the entire delay was unavoidable in order for the renewed petition to be considered grantable.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,240.00 for a large entity and \$620.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form PTO/SB/64 is enclosed for petitioner's convenience.

Petitioner is advised that because the request for extension of time within the third month pursuant to 37 CFR 1.136(a) filed by petitioner on December 22, 2000, was outside the maximum extendable period for reply petitioner will be refunded the associated fee of \$870.00 in due course.

Petitioner is also advised that the address as provided on the instant petition differs from the address of record. While a courtesy copy of this decision is being mailed to the address as cited on the petition, petitioner is advised that all future correspondence will be sent to the address of record until appropriate instructions are received to the contrary.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By facsimile: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 2201 South Clarke Place
 Crystal Plaza 4, Suite 3C23
 Arlington, Virginia 22202

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.




Beverly M. Flanagan
Supervisory Petitions Examiner
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Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: PTO/SB/64
 "Terminal Disclaimer to Accompany Petition"

cc: Michael I. Stewart
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